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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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12/23/2005

Jurgen Stetter

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EXAMINER

LEE, GILBERT Y

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/562,194	Applicant(s) STETTER ET AL.	
	Examiner GILBERT Y. LEE	Art Unit 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-19 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 1/25/08 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12-19, 21, 23, 25, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Weiss et al. (US Patent No. 5,727,791).

Note that the gasket of the Weiss et al. reference is being rotated 180 degrees.

Regarding claim 12, the Weiss et al. reference discloses a cylinder head gasket (1) for an internal combustion engine (Col. 1, Lines 9-15), insertable for the sealing of components having at least one T-junction (Fig. 2), said gasket having at least one functional layer (including 1' and 1'''), at least one distance layer (5), and at least one seal element (12) provided in the region of the T-junction (Fig. 4) wherein the distance layer has at least one recessed region (e.g. including 3 and 7) extending into one side of said distance layer less than completely through said distance layer to a seal engaging bottom surface (e.g. surface of element 5 in contact with element 12), said recessed region having a boundary region (e.g. ends of 7 furthest from 3) extending from said one side of said distance layer to said seal engaging bottom surface (Figs. 4

and 5), said recessed region receiving a portion of said seal element in engagement with said seal engaging bottom surface (Fig. 4), said portion of said seal element being spaced from at least a portion of said boundary region (Fig. 5) to provide a void space (e.g. space between ends of 7 and seal element 12) between said seal element and said boundary region.

Regarding claim 13, the Weiss et al. reference discloses the seal element protruding outwardly from the recessed region in the direction of at least one of the sealed components (Fig. 4) and being detached from said at least one functional layer (Fig. 4).

Regarding claim 14, the Weiss et al. reference discloses the distance layer abutting said at least one functional layer (Fig. 4), said at least one functional layer having an opening (e.g. portion of 2 that would be above 3) at least partially above said recessed portion sized to receive said seal element therethrough in detached fashion (Col. 4, Lines 36-41). Note that the distance layer of the Weiss et al. reference abuts the functional layer through element 1”.

Regarding claim 15, the Weiss et al. reference discloses the seal engaging bottom surface of said recessed region having a larger surface (e.g. surface of element 5 contacting 12) in cross-section than the cross-section of said opening (Fig. 4).

Regarding claim 16, the Weiss et al. reference discloses at least a part of said opening being provided above the recessed region and being essentially parallel thereto (Fig. 4). Note that the gasket of the Weiss et al. reference is being considered rotated 180 degrees.

Regarding claim 17, the Weiss et al. reference discloses the recessed region being generally oval in form (Fig. 5-7).

Regarding claim 18, the Weiss et al. reference discloses the seal element being partially supported on said one side of the distance portion surrounding the recessed region (e.g. Fig. 5).

Regarding claim 19, the Weiss et al. reference discloses the seal element being arranged in the recessed region without contacting the entire boundary region (e.g. end of 7 furthest from 3) of the recessed region and is supported by said bottom surface of the recessed region (Fig. 4).

Regarding claim 21, the Weiss et al. reference discloses at least one hollow channel (e.g. portions of 2 above 7) being formed in said functional layer, said hollow channel extending outwardly from said opening in open communication said opening and said seal element being partially received in said channel (Fig. 4).

Regarding claim 23, the Weiss et al. reference discloses said opening in said functional layer being at least partially spaced from said seal element (e.g. opening 2 at regions 7).

Regarding claim 25, the Weiss et al. reference discloses a cylinder head gasket (1) for an internal combustion engine (Col. 1, Lines 9-15), insertable for the sealing of components having at least one T-junction (Fig. 2), said gasket having at least one functional layer (including 1' and 1'''), at least one distance layer (5), and at least one seal element (12) provided in the region of the T-junction (Fig. 4) wherein the distance layer has at least one recessed region (e.g. including 3 and 7) extending into one side

of said distance layer less than completely through said distance layer to a seal engaging bottom surface (e.g. surface of element 5 in contact with element 12), said recessed region having a boundary region (e.g. ends of 7 furthest from 3) extending from said one side of said distance layer to said seal engaging bottom surface (Figs. 4 and 5), said at least one functional layer abutting said one side of said distance layer (Fig. 4) and having an opening (e.g. 2 in Fig. 4) at least partially above said recessed region, said recessed region remaining recessed and receiving a portion of said seal element therein upon the components being compressed together with said seal element being brought into engagement with said seal engaging bottom surface and said seal element extending through said opening in said functional layer (Fig. 4). Note that the recessed region remaining recessed is merely an intended use recitation and because the Weiss et al. reference discloses the structural limitations of a cylinder head gasket, the Weiss et al. reference will be **capable of** functioning in the manner as claimed.

Regarding claim 26, the Weiss reference discloses said seal element being spaced from at least a portion of said boundary region generally beneath said opening in said functional layer (Fig. 5) to provide a void space (e.g. space between ends of 7 and seal element 12) between said seal element and said boundary region.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. in view of Kubouchi et al. (US Patent No. 5,544,901).

Regarding claim 22, the Weiss et al. reference discloses the invention substantially as claimed in claim 12, including the sealing element being made of plastic (Col. 4, Lines 20-24).

However, the Weiss et al. reference fails to explicitly disclose the sealing element being made of silicone.

The Kubouchi et al., a cylinder head gasket including a sealing element, discloses that a sealing element can be made of resin or silicone rubber.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the sealing element of the Weiss et al. reference with silicone rubber in view of the teachings of the Kubouchi et al. reference in order to provide a material that is more malleable.

4. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. in view of Egloff (US Pub. No. 2001/0052674).

Regarding claim 24, the Weiss et al. reference discloses the invention substantially as claimed in claim 12, including the seal engaging bottom surface being curved.

However, the Weiss et al. reference fails to explicitly disclose the seal engaging bottom surface being planar.

The Egloff reference, a gasket, discloses making a bead (6) surrounding an opening in a gasket either curved or planar (Figs. 3-11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a planar bead to the Weiss et al. reference in view of the teachings of the Egloff reference in order to provide more uniform pressure to the sealing material when installed.

Response to Arguments

5. Applicant's arguments filed 1/25/08 have been fully considered but they are not persuasive.

With regards to the applicant's argument of claim 12, the argument is not persuasive because portions 3 and 7 clearly are closed by the bead of plate 5 and are therefore a part of plate 5 as well. The applicant argues that the bead of layer 5 can not correspond to the recessed portion of Applicant's claimed distance layer because the bead will be "flattened". This argument is not persuasive because the claims are only directed to a "cylinder head gasket". The structural limitations of the gasket are met by the Weiss et al. reference.

With regards to the applicant's argument of claim 18, the argument is not persuasive because, as stated above, the sealing material does not reach the end limits of duct 7; therefore, the sealing material is partially supported on the one side of the

distance layer into which the recessed region is formed surrounding the recessed region.

With regards to the applicant's argument of claim 19, the argument is not persuasive for the same reason as claim 18. The sealing material does not reach the end limits of duct 7. This is clearly evidenced in Col. 5, Lines 1-4, "dead spaces present are smaller". Since dead spaces are still presented, it is clear that the sealing material does not reach the end limits of duct 7. The applicant further argues that the gasket is flattened and therefore the distance layer will not have the claimed recess. This argument is not persuasive because the claims are only directed to a "cylinder head gasket" not a combination of a gasket and what it is installed in. Therefore, the structural limitations are met by the Weiss et al. reference.

With regards to the applicant's argument of claim 25, the argument is not persuasive because the claim is only directed to the subcombination of a "cylinder head gasket" with the internal combustion engine being merely intended use. The cylinder head gasket of the Weiss et al. reference is capable of function in the same manner as the current cylinder head gasket because all of the structural limitations are met.

With regards to the applicant's argument of claim 22, the argument is not persuasive because Col. 5, Lines 1-4 of the Weiss et al. reference clearly discloses that "dead spaces" are present. Therefore, the silicone worm would still be capable of functioning as the sealing material.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GILBERT Y. LEE whose telephone number is (571)272-5894. The examiner can normally be reached on 8:00 - 4:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia L. Engle can be reached on (571)272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3673

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patricia L Engle/
Supervisory Patent Examiner,
Art Unit 3673

/G. Y. L./
Examiner, Art Unit 3673